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10/656,789	09/05/2003	Thomas J. Foth	F-627	8969
7590	04/30/2009		EXAMINER	
Pitney Bowes Inc. Intellectual Property & Technology Law Department 35 Waterview Drive P.O. Box 3000 Shelton, CT 06484			ANDERSON, FOLASHADE	
			ART UNIT	PAPER NUMBER
			3623	
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			04/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,789	<b>Applicant(s)</b> FOTH ET AL.
	<b>Examiner</b> FOLASHADE ANDERSON	<b>Art Unit</b> 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 January 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,6-22 and 31-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,6-22 and 31-34 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 01/12/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection set forth below. Currently, claims 1-3, 6-22, and 31-34 are pending and claims 4, 5, and 23-30 have been canceled.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623.

***Response to Arguments***

2. In the argument section (VII A) Applicant argues with regards to the cited prior art of the previous office action: Cerwin (US Publication 2002/0188497) in view of Shoemaker et al (US Publication 2003/0167197 A1) :
  - a. Taken separately or together the references do not disclose or anticipate steps c, d and e of claim 1 (see pg 19-20)
  - b. Taken separately or together the references do not disclose or anticipate steps d2, d3 and d4 of claim 12 (see pg 20)
3. In the argument section (VII B) Applicant argues with regards to the cited prior art of the previous office action: Cerwin (US Publication 2002/0188497) in view of Shoemaker et al (US Publication 2003/0167197 A1) and in further view of Crockett et al. (2004/0039631 A1)
  - a. Taken separately or together the references do not disclose or anticipate steps c, d and e of claim 1 (see pg 22)
  - b. Taken separately or together the references do not disclose or anticipate steps d2, d3 and d4 of claim 12 (see pg 22)
  - c. In regards to claim 31 the prior art does not disclose or anticipate utilizing the weights assigned by the various users as weighted sums of the various users are responses to statements pertaining to various characteristics (see pg. 23)
  - d. In regards to claim 32 the prior art does not disclose or anticipate having characteristics include commitment, trust and satisfaction (see pg. 23)

- e. In regards to claim 33 the prior art does not disclose or anticipate having the weights assigned by various users to be weighted sums of the users responses to statements, pertaining to various characteristics (see pg. 23)
- 4. In the argument section (VII C) Applicant argues with regards to the cited prior art of the previous office action: Cerwin (US Publication 2002/0188497) in view of Shoemaker et al (US Publication 2003/0167197 A1) and in further view of Parker (US Publication 2002/0052774A1)
  - a. Taken separately or together the references do not disclose or anticipate steps c, d and e of claim 1 (see pg 24)
  - b. Taken separately or together the references do not disclose or anticipate steps d2, d3 and d4 of claim 12 (see pg 24)
- 5. In the argument section (VII D) Applicant argues with regards to the cited prior art of the previous office action: Cerwin (US Publication 2002/0188497) in view of Couchot et al ( US Publication 2003/0065553 A1)
  - a. Taken separately or together the references do not disclose or anticipate steps c, d and e of claim 1 (see pg 25)
  - b. Taken separately or together the references do not disclose or anticipate steps d2, d3 and d4 of claim 12 (see pg 25)
- 6. In the argument section (VII D) Applicant argues with regards to the cited prior art of the previous office action: Cerwin (US Publication 2002/0188497) in view of Couchot et al ( US Publication 2003/0065553 A1) and further in view of Feher (US Publication 2004/0002893A1)

- a. Feher does not disclose that the data will be collected and distributed by the third party in a secure manner to protect critical confidential information of the enterprise with respect to claims 9 and 20 (see page 26).
7. Applicant's arguments, (2a), (2b), (3a), (3b), (4a), (4b), (5a), (5b) and (6a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.
8. Applicant's arguments (3c) and (3e) have been fully considered but they are not persuasive. In response to Applicant's argument (3c) and (3e) the Examiner respectfully disagrees Crockett et al teaches in an analogous art "the computer system can generate an overall assessment . . . using a weighted score (equivalent of the weighted sums) of each of the capabilities (characteristics)," (paragraph 0007 and the method in paragraph 0006), "value of the weights assigned to each of the capabilities . . . weights can be based on a combination of the following factors user and/or academic research, user experience, and common sense and logic," (paragraph 0030) and "[t]he tool can then prompt users to answer questions . . . used by the tool to score the capabilities," (paragraph 0022). This disclosure renders the instant limitation of "wherein the weights assigned by the various users are weighted sums of the various users are responses to statements pertaining to various characteristics" obvious.
9. Applicant's arguments (3d) have been fully considered but they are not persuasive. In response to Applicant's argument (3d) the Examiner respectfully disagrees Crockett et al teaches in an analogous art characteristics (capabilities) (paragraph 0007) and assign weights to the characteristics (capabilities) (paragraph

0030) as discussed above with respect to claim 31 from which this claim depends; however he does not expressly teach that the characteristics are "commitment, trust, and satisfaction;" however, these identifiers are simply descriptive material which does not functional change the nature of the method; therefore no patentable weight has been given to the limitation. The recited method steps would be performed the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 6-8, 10-19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al. (US Patent 5,765,138) in view of Piggot et al (US Publication 2002/0156736).

**Claim 1 and 12**

Aycock teaches a method for controlling a system for automatically generating and distributing information, comprising the steps of:

- a) monitoring a document as it is processed by a user (col.10, lines 29-33);
- c) accessing a database that stores information about various users including weights assigned by the various users (col. 2, lines 65-67 and col. 3, lines 1-3; where the business system includes a database see fig. 2);
- d) accessing a database of information relating to relationships between an enterprise and other parties wherein said information includes a value of said relationship to said enterprise, a quality of said relationship to said enterprise and the weights assigned by the various users (col. 3, lines 9-13 and 46-51 ); and
- e) if a record relating to said party exists in said database, providing information relating to a relationship between said enterprise and said party to said user (col. 11, lines 23-30).

Aycock does not expressly teach b) identifying a reference to a party in said document; however it is implied in the reference where the vendor/supplier identification must be tied to the responses submitted via the supplier system (col. 9, lines 17-21 and 64-66 or in the information stored to the vendor database (fig. 2); therefore this limitation would have been obvious to one of ordinary skill in the art at the time the invention was made.

Official Notice is taken that b) identifying a reference to a party in said document was old and well known in the art at the time the invention was made as evidenced by Piggot (0014);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Aycock the b) identifying a reference to a party in said document as taught by what was old and well known in the art at the time the invention was made since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 12 is the system used to implement claim 1 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above. Further Aycock teaches the additional limitations of claim 12:

- a) a computer for processing documents (col. 4, lines 28-31);
- b) a database system comprising (fig. 2 # 62, 64, 66):

- b1) a database of information relating to relationships between an enterprise and other parties (col. 9, lines 37-58); and
- b2) a server for controlling access to said database and for communicating with said computer (col. 15, lines 29-42); where
- c) said computer is programmed to:
  - c3) send information identifying said party to said server (abstract and col. 15, lines 40-43; where it is inherent that identifying information is contained in the response); and where
  - d) said server is programmed to (col. 15, lines 31-33):
    - d1) receive said identifying information (abstract and col. 15, lines 40-43);

Claim 2 and 13

Aycock teaches all the limitation of claim 1 where said information is generated, at least in part, based upon survey responses by system users (col. 3, lines 27-35; where an rfp/rfq is an old and well known method of surveying vendors/suppliers).

Claim 13 is the system used to implement claim 2 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 3 and 14

Aycock teaches all the limitation of claim 2 where said user is requested to respond to a survey when said information is provided (col. 3, lines 27-35).

Aycock does not expressly teach said user's response to said survey is used to update said information.

Piggot teaches said user's response to said survey is used to update said information (0082).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Aycock the user's response to said survey is used to update said information as taught by Piggot since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 14 is the system used to implement claim 3 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 6 and 17

Aycock teaches all the limitation of claim 1 where said further information includes a weighted sum of ratings for a plurality of characteristics of said relationship (col. 3, lines 3-13).

Claim 17 is the system used to implement claim 6 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 7 and 18

Aycock teaches all the limitation of claim 1 where said further information is provided in graphical form (col. 10, lines 23-25 and col.13, lines 20-27).

Claim 18 is the system used to implement claim 7 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 8 and 19

Aycock teaches all the limitation of claim 1 however Aycock is silent on where said information is generated, at least in part, based upon survey responses by other enterprises.

Piggot teaches where said information is generated, at least in part, based upon survey responses by other enterprises (0018).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Aycock the said information is generated, at least in part, based upon survey responses by other enterprises as taught by Piggot since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 19 is the system used to implement claim 8 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 10

Aycock teaches all the limitation of claim 1 including the further step of formulating an inquiry to an information source in response to a request from said user (col. 10, lines 28-33).

Claim 11 and 22

Aycock teaches all the limitation of claim 10 where the scope of said inquiry, and to which information source, or sources, said inquiry is to be sent, are determined based on the nature and importance of the matter to which said inquiry relates (col.9, lines 13-16 and col. 13, lines 29-34).

Claim 22 is the system used to implement claim 11 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 15

15. A system as described in claim 12 where said information sent relates to a value of said relationship to said enterprise (col. 7, lines 46-65; where the relationship is in whether the vendor/supplier becomes an approved supplier or is rejected).

Claim 16

16. A system as described in claim 15 where said sent information includes further information relating to a quality of said relationship (col. 5, lines 1-5).

Claim 21

21. A system as described in claim 12 where said computer is further programmed to receive a request from said user for information from other information

sources (col. 9, lines 13-16) and said server is further programmed to formulate an inquiry to an information source in response to said request (col. 13, lines 29-34).

12. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al. (US Patent 5,765,138) and Piggot et al (US Publication 2002/0156736) in further view of Klingman (US Patent 5,950,173).

Claim 9 and 20

Aycock and Piggot teaches all the limitation of claim 8; however neither teaches where said other enterprise responses are collected and distributed by a third party in a confidential and secure manner to protect critical confidential information of said other enterprises.

Klingman teaches where said other enterprise responses are collected and distributed by a third party in a confidential and secure manner to protect critical confidential information of said other enterprises (abstract and col. 14, lines 49-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Aycock and Piggot the said other enterprise responses are collected and distributed by a third party in a confidential and secure manner to protect critical confidential information of said other enterprises as taught by Klingman since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 20 is the system used to implement claim 9 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

13. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al. (US Patent 5,765,138) and Piggot et al (US Publication 2002/0156736) in further view of Crockett et al (US Publication 2004/0039631)

Claim 31 and 33

Aycock and Piggot teaches all the limitation claim 1, Aycock further teaches assigning weights to vendor requirements (characteristics) (col.3, lines 63-67); however Aycock and Piggot are silent on wherein the weights assigned by the various users are weighted sums of the various users are responses to statements pertaining to various characteristics.

Crockett teaches wherein the weights assigned by the various users are weighted sums of the various users are responses to statements pertaining to various characteristics (0006-07, 0022 and 0030).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Aycock and Piggot the wherein the weights assigned by the various users are weighted sums of the various users are responses to statements pertaining to various characteristics as taught by Crockett since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 33 is the system used to implement claim 31 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

Claim 32 and 34

The combination of Aycock and Piggot in view of Crockett teaches “wherein the weights assigned by the various users are weighted sums of the various users are responses to statements pertaining to various characteristics”. Aycock and Piggot in view of Crockett does not expressly teach the specific data recited in claims “wherein the characteristics include commitment, trust and satisfaction”; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.32.*

Claim 34 is the system used to implement claim 32 and is therefore implied in and substantially similar to this claim and is therefore rejected for the same reasoning given above.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spaid (US Patent 7,269,643) teaches surveying user using ranking and weighting factors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/  
Examiner, Art Unit 3623

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/Beth V. Boswell/  
Supervisory Patent Examiner, Art Unit 3623